### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Patent Application of:<br>Masakatsu KIWADA et al. | |
| Application No. 10/079,603 | Confirmation No. 8470 |
| Filed: February 22, 2002 | Art Unit: 2145 |
| For:  IMAGE PROCESSING METHOD, IMAGE<br>PROCESSING SYSTEM, AND RELATED<br>EQUIPMENT USED THEREIN INCLUDING<br>PORTABLE TERMINAL, IMAGE FORMING<br>DATA TRANSMITTING DEVICE AND<br>IMAGE FORMING DEVICE, AS WELL AS<br>IMAGE PROCESSING PROGRAM AND<br>COMPUTER READABLE RECORDING<br>MEDIUM THAT STORES SAID PROGRAM | Examiner: Adnan M. Mirza |

### PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir or Madam:

Applicants respectfully request review of the final rejection dated July 10, 2008. Applicants

are filing a Notice of Appeal concurrently herewith.

I.      THE REJECTION OF CLAIMS 1-32, 34, 36, 38, 40, and 41 UNDER 35 USC 103(a)
        FAILS BECAUSE THE CITED REFERENCES OMIT SEVERAL OF THE CLAIMED
        FEATURES

Claims 1-32, 34, 36, 38, 40, and 41 stand rejected under 35 USC 103(a) on Friday (U.S.

Patent No. 6,631,453) in view of Kenworthy (U.S. Patent No. 6,317,837). Friday and Kenworthy,

taken individually or in combination, fail to disclose or suggest several of the claimed features.

        1.      Friday Fails to Disclose Several of the Claimed Features

The Examiner asserts that Friday discloses the subject matter of claim 1, with the exception

of the first and second bi-directional connections between the respective first and second internal networks and the external network. (See, Office Action, section 3.) Applicants disagree.

Friday not only fails to disclose the bi-directional connections, but also fails to disclose or suggest at least the following additional features recited in claim 1: (a) a portable terminal, (b) an image data transmission device, (c) a printing device, (d) a file server, (e) first and second firewalls, (f) establishing a connection between a portable terminal and an image data transmission device, and (g) transmitting an image printing request. Friday fails to mention *any* these features. In addition, Friday fails to disclose the recited relationships between these features. Moreover, the Examiner has failed to even indicate which elements of Friday are believed to constitute these features or to respond to Applicants arguments regarding these features.

Applicants have addressed Friday's failure to disclose these features in previous responses, as discussed below.

> (a)-(c)  Portable Terminal, Image Data Transmission Device, Printing Device

Applicants addressed Friday's failure to disclose features (a)-(c) on page 23, line 9 – page 24, line 10 of Applicants' response dated October 30, 2007 (hereafter, "the Oct. 30 response"), and on page 4, lines 10-25 of Applicants' response dated April 15, 2008 (hereafter, "the Apr. 15 response"). As discussed in the responses, features (a)-(c) are completely absent from Friday's disclosure.

> (d)      File Server

Applicants addressed Friday's failure to disclose feature (d) on page 5 of the Apr. 15 response. As discussed in the response, nothing in the cited passages of Friday relates to printing, let alone uploading or downloading print jobs to a file server. Thus, no part of Friday performs a similar function to the file server recited in claim 1.

> (e)      First and Second Firewalls

Applicants addressed Friday's failure to disclose the first and second firewalls on page 22 of

the Oct. 30 response, and on pages 3-4 of the Apr. 15 response. As discussed in the responses, Friday teaches a system in which firewalls are intentionally <u>not used</u>. In other words, Friday acknowledges the existence of firewall technology and specifically teaches away from its use due to alleged security weaknesses of firewalls. (See, Friday, col. 2, lines 8-17.) Friday instead teaches the use of hardware-based systems that overcome the alleged weaknesses of firewalls. (Id.)

        (f)    <u>Establishing a Connection Between a Portable Terminal and an Image Data Transmission Device</u>

Applicants addressed Friday's failure to disclose feature (f) on page 23, line 19 – page 24, line 10 of the Oct. 30 response. As discussed in the response, Friday does not disclose a connection between computers 12 and 14. Moreover, Friday's computers 12 and 14 do not constitute a portable terminal and an image data transmission device as claimed.

        (g)    <u>Transmitting an Image Printing Request</u>

Applicants addressed Friday's failure to disclose feature (g) on page 24, line 20 – page 25, line 5 of the Oct. 30 response, and on page 6, lines 20-23 of the Apr. 15 response. As discussed in the responses, Friday fails to disclose the transmission of any request from one device to another, let alone an image printing request.

    2.    <u>Kenworthy Fails to Cure Friday's Defects</u>

The Examiner relies on Kenworthy to cure Friday's failure to disclose the claimed "bi-directional" connections. However, Kenworthy fails to disclose bi-directional connections as claimed.

Applicants addressed Kenworthy's failure to disclose the claimed bi-directional connections on page 6 of the Apr. 15 response, and on page 24, lines 11-19 of the Oct. 30 response. As explained in the responses, while Kenworthy uses the term "multi-directional access control" to describe a firewall management system NADFW-MS 111, the term does not mean what the Examiner has asserted it to mean. In Kenworthy, "multi-directional access control" means

controlling data packet access from multiple different network connections, which is different from the bi-directional connections recited in claim 1.

Kenworthy also fails to cure Friday's failure to disclose features (a)-(g) above. For instance, Kenworthy fails to disclose a portable terminal arranged to transmit data to an image data transmission device across two different firewalls. Kenworthy also fails to disclose transmitting an image printing request or uploading or downloading print jobs. While Kenworthy does disclose the use of firewalls, Kenworthy fails to disclose establishing connections and transmitting information across first and second firewalls in the claimed arrangement.

Because Kenworthy fails to disclose the claimed bi-directional connections, as well as features (a)-(g), Kenworthy fails to cure Friday's defects.

       3.    <u>Conclusion</u>

Because Friday and Kenworthy fail to disclose or suggest any of features (a)-(g), or the claimed "bi-directional connections", the rejection of claim 1 is improper and should be withdrawn. Claims 2-32, 34, 36, 38, 40, and 41 either depend from claim 1 or recite features similar to those discussed above in relation to claim 1. Accordingly, these claims are patentable over Friday and Kenworthy for reasons similar to those presented above.

II.    <u>THE REJECTION OF CLAIMS 1-32, 34, 36, 38, 40, and 41 UNDER 35 USC 103(a) ALSO FAILS BECAUSE THE EXAMINER DID NOT SHOW PROPER MOTIVATION FOR MODIFYING FRIDAY IN VIEW OF KENWORTHY</u>

The Examiner asserts that it would be obvious to modify Friday to incorporate a firewall management system NADFW-MS 111 in order to "provide data secure environment for business to business computing." (See, Office Action, p. 4.) This does not constitute proper motivation for combining Friday with Kenworthy. Moreover, the Examiner has failed to respond to Applicants remarks regarding the non-obviousness to combine Friday and Kenworthy.

As discussed both above and on pages 22-23 of the Oct. 30 response and pages 3-4 of the Apr. 15 response, Friday teaches away from the use of a firewall and uses a hardware-based system

4

instead of a firewall. Thus a person skilled in the art would have seen no need for using a firewall management system NADFW-MS in Friday. Moreover, it is not clear what additional security benefits, if any, would be gained by Friday from the addition of NADFW-MS, given that the whole point of Friday is to provide data security that exceeds that provided by firewalls.

Because the Examiner has failed to show proper motivation for combining Friday and Kenworthy, the rejection of claims 1-32, 34, 36, 38, 40, and 41 should be withdrawn.

III.    THE REJECTION OF CLAIMS 1, 40 AND 41 UNDER 35 USC 112, FIRST PARAGRAPH, FAILS BECAUSE THE CLAIMED UNI-DIRECTIONAL CONNECTION IS SUPPORTED BY THE SPECIFICATION

The Examiner rejected claims 1, 40, and 41 under 35 USC 112, first paragraph, alleging that the claimed uni-directional connection is not supported by the specification. Applicants disagree.

The specification discloses the claimed uni-directional connections at paragraphs [0051], [0055], [0058], and [0060]. For instance, paragraph [0051] recites "A firewall is normally provided with a port that is *capable of connection only from the internal network to the external network*." (emphasis added.)

Because the specification provides support for the claimed uni-directional connections, the rejection of claims 1, 40, and 41 is improper and should be withdrawn.

IV.    CONCLUSION

In light of the above, a Notice of Allowance is solicited.

Dated: October 9, 2008                          Respectfully submitted,

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